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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,792	08/25/2006	Wayne H. Rothschild	47079-00295USPX	1114
70243	7590	06/22/2009	EXAMINER	
NIXON PEABODY LLP			MOSSER, ROBERT E	
300 S. Riverside Plaza			ART UNIT	
16th Floor			PAPER NUMBER	
CHICAGO, IL 60606			3714	
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			06/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,792	Applicant(s) ROTHSCHILD ET AL.	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,21-26 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,21-26 and 35-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/13/06; 1/15/08</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement(s) entered 10/13/2006 and 1/15/2008 have been considered. A copy of the cited statement(s) including the notation indicating its respective consideration is attached for the Applicant's records.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-2, 4, 6-13, 21-23, 25-26, and 35-42** are rejected under 35 U.S.C. 102(e) as being anticipated by Luciano Jr. (USP 6,811,486).

Claims **1-2, 10, 22, 35, and 39**: Luciano teaches a method and apparatus for conducting a wagering game including:

- receiving wagers/bets from a player for each play of a game;
- randomly determining a first game outcome on a first machine;
- providing the player a game asset if the first outcome matches a predetermined outcome wherein the game asset alters a second game outcome;

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randomly determining a second game outcome on the first machine or a second machine;

receiving the game asset from the player and modifying the game outcome responsive to the receipt of the game asset; and

awarding the player for winning game outcomes (*Luciano* Abstract Col 1:23-2:14, 5:1-15, 5: 56-6:44; 8:8-29 Figure 5, 7, 8).

Claims **4** and **23**: *Luciano* teaches the transfer of game assets using ticket based embodiments (*Luciano* Figure 3 Col 7:9-21).

Claim **6**: *Luciano* teaches the transfer of game assets using player IDs and player ID readers (*Luciano* Col 8:58-9:18 10:44-58).

Claims **7-9**, **36-38**, and **40-41**: *Luciano* further teaches that the game asset may have various effects including: the designation of a wild symbol; transposition or re-spinning of game symbols; the addition of paylines; altering the probability and size of the award (changing payable); providing the player with a predetermined game segment or bonus game; payline multipliers, and adding value to a bonus game outcome through the altering of bonus game pay tables (*Luciano* Figure 5 Col 8:30-47).

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Claims **10-13**: Luciano teaches that the player may receive a plurality of game assets and redeem a portion or all of their game assets as desired (*Luciano* Figures 7-8; Col 8:12-23; 12:20-13:9).

Claims **21, 25-26**, and **42**: Luciano teaches the use of a plurality of game levels including the incorporation of bonus games and assets that provide instant bonus game plays and wherein further the base game and bonus games are understood to have respective prizes associated therewith(*Luciano* Col 8:30-47, 9:19-47),

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims **5** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano Jr. (USP 6,811,486) as applied to at least claims 1, and 21 above, and further in view of Baltz et al (US 6,852,029).

Luciano teaches the invention as taught above including the incorporation of a bill validator and ticket reader (*Luciano* Elm 106, 204 Col 5:56-6:26), however Lucian does not explicitly teach merging of the bill validator and ticket reader into a singular device. In a related invention Baltz teaches a device for use with electronic gaming machines adapted to provide a bill validator and ticket reader in a singular device such that the bill validator is operable to read printed tickets (*Baltz* Elm 316). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the bill validator and ticket reader as a singular device such as taught by Baltz into the invention of Luciano in order to remove the added cost of incorporating two separate readers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

/R. M./
Examiner, Art Unit 3714